

Application No. 10/758,380
Response to OA of 01/10/2006

Remarks

In the present response, claims 7, 11, 22, 30 and 35-51 are presented for examination.

I. Claims Rejection: 35 USC § 102(b)

Claim 11 is rejected under 35 USC § 102(b) as being anticipated by USPN 5,689,654 (Kikinis). Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 11

Claim 11 recites numerous limitations that are not taught or suggested in Kikinis. By way of example, claim 11 recites:

interface elements are exposed on the externally accessible side for use when the multi-functional device is inserted into the internal device bay and when the multi-functional device is removed from the internal device bay; and

the interface elements comprise at least one of a removable media aperture, an eject button, a volume control dial, a headphone jack and a tuner knob.

Nowhere does Kikinis teach or suggest these recitations. The Office Action cites FIGS. 5 and 22 of Kikinis. Applicants respectfully disagree. FIG. 5 shows a PDA 10 that is docked in a notebook computer 172. Kikinis does not teach or suggest that the PDA 10 has interface elements exposed on an externally accessible side for use when the PDA 10 is inserted into the notebook computer 172 and when the PDA 10 is removed from the bay of the notebook computer 172.

FIG. 22 shows a notebook computer 1011 (see FIG. 21A) having a plurality of modules or bays (1019, 1021, 1023, etc.). Kikinis does not teach or suggest that the PDA

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that inserts into the notebook 1011 of FIG. 22 has interface elements exposed on an externally accessible side for use when the PDA is inserted into the notebook computer 1011 and when the PDA is removed from the bay of the notebook computer 1011.

For at least these reasons, claim 11 is allowable over Kikinis.

II. Claims Rejection: 35 USC § 102(b)

Claims 39-40 are rejected under 35 USC § 102(b) as being anticipated by USPN 20020008497 (Tanaka). Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Tanaka neither teaches nor suggests all the elements of the claims, these claims are allowable over Tanaka.

Claim 39

Claim 39 recites numerous limitations that are not taught or suggested in Tanaka. By way of example, claim 39 recites:

the video device has a first set of functions when the video device is inserted into the internal device bay and connected to the electrical connector and a second set of functions when removed from the internal device bay;

the first set of functions includes playing video content through the display screen of the computer; and

the second set of functions includes playing the video content through the display screen of the video device.

Nowhere does Tanaka teach or suggest these recitations. The Office Action cites FIG. 2 of Tanaka and notes video device 165 in Tanaka. Applicants respectfully disagree. Element 165 is a digital video disk, not a device as claimed. Further, this disk 165 does not have the claimed two sets of functions are recited in claim 39.

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For at least these reasons, claim 39 and its dependent claims are allowable over Tanaka.

III. Claims Rejection: 35 USC § 102(b)

Claims 43-45 are rejected under 35 USC § 102(b) as being anticipated by USPN 5,768,163 (Smith). Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Smith neither teaches nor suggests all the elements of the claims, these claims are allowable over Smith.

Claim 43

Claim 43 recites numerous limitations that are not taught or suggested in Smith. By way of example, claim 43 recites a camera having a body that is insertable into an internal device bay of the personal electronic system. Smith does not teach or suggest this recitation. The Office Action cites elements 11 and 32 of Smith. Applicants respectfully disagree. In Smith, element 11 is a media clip that "can be attached to or detached from portable computer 10 and/or a desktop computer" (3: 30-33). This media clip is not an internal device bay. In Smith, element 32 also attaches to a housing of the portable or desktop computer.

For at least these reasons, claim 43 and its dependent claims are allowable over Smith.

IV. Claims Rejection: 35 USC § 102(b)

Claims 47-48 are rejected under 35 USC § 102(b) as being anticipated by USPN 20020008497 (Tanaka). Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

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Since Tanaka neither teaches nor suggests all the elements of the claims, these claims are allowable over Tanaka.

Claim 47

Claim 47 recites numerous limitations that are not taught or suggested in Tanaka. By way of example, claim 47 recites a video device having:

a body insertable at least partially into the internal device bay
of the personal electronic system;

a mating electrical connector adapted to connect to the
electrical connector of the personal electronic system upon
inserting the video device into the internal device bay; and

a display screen;

and wherein:

the video device operates in a first functional capacity
when inserted at least partially into the internal device bay and
connected to the electrical connector;

the video device operates in a second functional
capacity when removed from the personal electronic system;

the first set of functions includes playing video content
through the display screen of the personal electronic system; and

the second set of functions includes playing the video
content through the display screen of the video device.

Nowhere does Tanaka teach or suggest these recitations. The Office Action cites FIG. 2 of Tanaka and notes video device 165 in Tanaka. Applicants respectfully disagree. Element 165 is a digital video disk, not a device as claimed. Further, this disk 165 does not have the claimed two sets of functions are recited in claim 39.

For at least these reasons, claim 47 and its dependent claims are allowable over Tanaka.

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V. Claims Rejection: 35 USC § 103(a)

Claims 7 and 22 are rejected under 35 USC § 103(a) as being unpatentable over Kikinis in view of Tanaka. Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

No Suggestion/Motivation to Modify or Combine References

For at least the following reasons, no suggestion or motivation exists to modify and/or combine Kikinis and Tanaka.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Kikinis is directed to personal digital assistants (PDAs) and their docking systems (see 1: 24-28, Summary, etc.) By contrast, Tanaka is directed to functional expansion devices (shown as various drives) that are inserted into a bay of a computer.

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Kikinis, the Background section discusses numerous problems with prior art PDAs (example, such PDAs are too costly, too large, have poor data transfer, etc.). By contrast in Tanaka, the Background section discusses numerous problems with prior art

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functional expansion devices (example, floppy drives or optical drives) for notebook computers.

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in Kikinis and Tanaka, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicants respectfully ask the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

All Elements Not Taught or Suggested

Even assuming *arguendo* that Kikinis and Tanaka are combinable (which they are not), the combination does not teach or suggest all of the elements of the claims.

Claims 7 and 22

As one example, claim 7 recites that the multi-functional devices comprises at least one of a ... DVD player. Claim 22 recites a similar recitation. The Office Action argues that FIG. 2 of Tanaka teaches this recitation. Applicants respectfully disagree. Element 165 in FIG. 2 of Tanaka is a DVD disk, not a multi-functional device. This disk 165 is inserted into a DVD drive 160. The DVD drive in Tanaka, however, is not a multi-functional device as recited in claims 7 and 22.

For at least these reasons, claims 7 and 22 are allowable over Kikinis and Tanaka.

VI. Claims Rejection: 35 USC § 103(a)

Claim 30 is rejected under 35 USC § 103(a) as being unpatentable over Kikinis in view of Tanaka. Applicants respectfully traverse.

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No Suggestion/Motivation to Modify or Combine References

For at least the reasons noted above in connection with section V, no suggestion or motivation exists to modify and/or combine Kikinis and Tanaka.

For at least these reasons, Applicants respectfully asks the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

All Elements Not Taught or Suggested

Even assuming *arguendo* that Kikinis and Tanaka are combinable (which they are not), the combination does not teach or suggest all of the elements of the claims.

Claim 30

As one example, claim 30 recites that the multi-functional devices comprises at least one of a ... DVD player. The Office Action argues that FIG. 2 of Tanaka teaches this recitation. Applicants respectfully disagree. Element 165 in FIG. 2 of Tanaka is a DVD disk, not a multi-functional device. This disk 165 is inserted into a DVD drive 160. The DVD drive in Tanaka, however, is not a multi-functional device as recited in claim 30.

For at least these reasons, claim 30 is allowable over Kikinis and Tanaka.

VII. Claims Rejection: 35 USC § 103(a)

Claims 35-38 is rejected under 35 USC § 103(a) as being unpatentable over Kikinis in view of Smith. Applicants respectfully traverse.

No Suggestion/Motivation to Modify or Combine References

For at least the following reasons, no suggestion or motivation exists to modify and/or combine Kikinis and Smith.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Kikinis is directed to personal digital assistants (PDAs) and their docking systems (see 1: 24-28, Summary, etc.) By contrast, Smith is directed to a hinged connector attached to an outer housing of a computer. The hinged connector receives media clip pad and camera.

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The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In *Kikinis*, the Background section discusses numerous problems with prior art PDAs (example, such PDAs are too costly, too large, have poor data transfer, etc.). By contrast in *Smith*, the Background section discusses numerous problems with prior art notebook computers because they do not use personal information management (PIM) devices.

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in *Kikinis* and *Smith*, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicants respectfully ask the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

All Elements Not Taught or Suggested

Even assuming *arguendo* that *Kikinis* and *Smith* are combinable (which they are not), the combination does not teach or suggest all of the elements of the claims.

Claim 35

As one example, claim 35 recites a camera that is insertable into an internal device bay of the personal electronic system. *Smith* does not teach or suggest this

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recitation. The Office Action cites elements 11 and 32 of Smith. Applicants respectfully disagree. In Smith, element 11 is a media clip that "can be attached to or detached from portable computer 10 and/or a desktop computer" (3: 30-33). This media clip is not an internal device bay. In Smith, element 32 also attaches to a housing of the portable or desktop computer.

For at least these reasons, claim 35 and its dependent claims are allowable over Kikinis and Smith.

VIII. Claims Rejection: 35 USC § 103(a)

Claim 41 is rejected under 35 USC § 103(a) as being unpatentable over Tanaka in view of USPN 5,740,012 (Choi). Applicants respectfully traverse.

As noted above, Tanaka fails to teach or suggest all the recitations of independent claim 39. Choi fails to cure the deficiencies of Tanaka. Claim 41 depends from independent claim 39. Thus, for at least the reasons given in connection with independent claim 39, dependent claim 41 is allowable over Tanaka in view of Choi.

IX. Claims Rejection: 35 USC § 103(a)

Claim 46 is rejected under 35 USC § 103(a) as being unpatentable over Smith. Applicants respectfully traverse.

As noted above, Smith fails to teach or suggest all the recitations of independent claim 43. Claim 46 depends from independent claim 43. Thus, for at least the reasons given in connection with independent claim 43, dependent claim 46 is allowable over Smith.

X. Claims Rejection: 35 USC § 103(a)

Claim 49 is rejected under 35 USC § 103(a) as being unpatentable over Tanaka. Applicants respectfully traverse.

As noted above, Tanaka fails to teach or suggest all the recitations of independent claim 47. Claim 49 depends from independent claim 47. Thus, for at least the reasons given in connection with independent claim 47, dependent claim 49 is allowable over Tanaka.

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XI. Claims Rejection: 35 USC § 103(a)

Claim 50 is rejected under 35 USC § 103(a) as being unpatentable over Tanaka in view of USPN 5,740,012 (Choi). Applicants respectfully traverse.

As noted above, Tanaka fails to teach or suggest all the recitations of independent claim 47. Choi fails to cure the deficiencies of Tanaka. Claim 50 depends from independent claim 47. Thus, for at least the reasons given in connection with independent claim 47, dependent claim 50 is allowable over Tanaka in view of Choi.

XII. Claims Rejection: 35 USC § 103(a)

Claims 51 and 42 are rejected under 35 USC § 103(a) as being unpatentable over Tanaka. Applicants respectfully traverse.

Claim 42

Claim 42 recites numerous recitations that are not taught or suggested in Tanaka. For example, claim 42 recites:

the MP3 player has a first set of functions when the MP3 player is inserted into the internal device bay and connected to the electrical connector and a second set of functions when removed from the internal device bay;

the first set of functions includes playing MP3 content through the speaker of the computer; and

the second set of functions includes playing the MP3 content through the speaker of the MP3 player.

Tanaka does not teach or suggest these recitations. The Office Action argues that Tanaka teaches a CD player that meets the claimed recitations. Applicants respectfully disagree. Claim 42 recites that the MP3 player performs two different functions: A first set of functions when the MP3 player is connected to the internal bay and a second set of functions when the MP3 player is removed from the bay. First, Tanaka does not even

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teach or suggest a CD player that has these two functions. Tanaka teaches a bay housing 70 that receives different drives, such as a CD drive 130. This CD drive, though, is not multi-functional as recited in claim 42.

For at least these reasons, claim 42 is allowable over Tanaka.

Claim 51

Claim 51 recites numerous recitations that are not taught or suggested in Tanaka. For example, claim 51 recites a television having two sets of functions. Tanaka is completely silent on these recitations. Nowhere whatsoever does Tanaka teach or suggest televisions having two sets of functions as recited in claim 51.

For at least these reasons, claim 51 is allowable over Tanaka.

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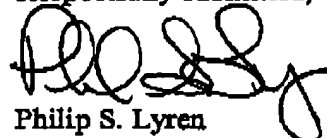
CONCLUSION

In view of the above, Applicants believe that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

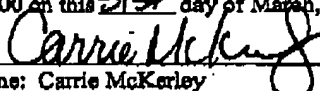


Philip S. Lyren
Reg. No. 40,709
Ph: 281-514-8236

CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 31st day of March, 2006.

By



Name: Carrie McKerley